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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/502,056	09/02/2004	Christian Kuhrs	256198US0PCT	2493
22850	7590	03/31/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			NYALLEY, LANSANA	
			ART UNIT	PAPER NUMBER
			1621	

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/502,056

Applicant(s)

KUHRIS ET AL

Examiner

Lansana Nyalley

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 16-32 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

*Restrictions*

- 1). This is a 371 of PCT/EP03/01093 filed on 02/04/2003 which claims benefit of the foreign applications of GERMANY 10204608.5 filed on 02/05/2002; GERMANY 10236254.8, filed on 08/07/2002.
- 2). Claims 1-15 are cancelled by preliminary amendment.
- 3). Claims 16-32 are pending.

**Lack of unity**

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following claims or groups of claims, which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Claims 16-32 of this application require restriction.

**Group I**, claims 16-26, directed to a catalyst composition for the oxychlorination of ethylene, classified in class 502, subclass 100+.

**Group II**, claim 27, directed to a fixed- bed catalyst, classified in class 502, subclass 62

**Group III**, claims 28-32, directed to a process for preparing 1,2-dichloroethane, classified in class 570, subclass 101, 243 and 245.

Groups I-III, in the instant application, do not relate to a single, general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons. The technical feature linking the groups relates to a 1,2-dichloroethane. There is no special technical feature if the compound, 1,2-dichloroethane,

can be made by any other process, using any other catalyst composition, than the one specifically claimed in the instant application or that the catalytic composition or the process can be used to make any other compound different from the 1,2-dichloroethane claimed in the instant application. This technical feature does not make a contribution over the prior art.

Group I is directed to a catalytic composition which do not necessarily require the particulars of Group II, which is directed to a fixed-bed catalyst nor does it require the particulars of Group III, which is directed to a process of making 1,2-dichloroethane.

Group II, directed to a fixed-bed composition, does not necessarily require the particulars Group III, which is directed to the process of preparing 1,2-dichloroethane.

There is no special technical feature, which unites the groups. But even if there were a special technical feature, there must be unity of invention also. Under 37 CFR 1.475,

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("the requirement of unity of invention."). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical feature. The expression, "special technical feature" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of inventions will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of the said product; or
- (2) A product and a method of use of the said product; or
- (3) A product, a process specially adapted for the manufacture of the said product and a method of use of the said product; or
- (4) A process and an apparatus or means specially designed for the carrying out of the said process; or
- (5) A product, a process specially adapted for the manufacture of the said

Product, and an apparatus or means specially designed for the carrying out of the said process.

The above groups, together, do not meet the requirement of the unity of invention as given above in items 1-5.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper.

Applicant is not entitled to the search of multiple processes and products but to one set of process, product, method of use and composition drawn to the same compound. The search in the non-patent literature for the products, process of making a compound, a method of using a compound and the composition of a compound within one group may not necessarily lead to the products, process of making a compound, a method of using a compound and the composition of a compound of the other group or groups. Thus, the search will present a burden on the examiner.

Affirmation of this non-election must be made by the applicant in response to this office action.

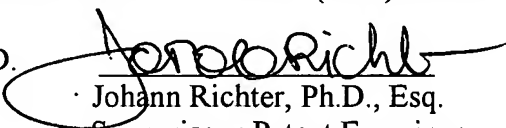
A telephone call was made to Gregory P. LaPointe, phone number 203-777-6628, Ex.111 on 03-10-05, to request an oral election to the above restriction requirement, but did not result in an election being made.

## CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lansana Nyalley whose telephone number is 571,272,0697 and the fax number is 703-746-3098. The examiner can normally be reached on 7:45 to 4:45 and the fax number is 703-746-3098.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0697. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866- 217-9197 (toll-free)

Lansana Nyalley, Ph. D.  
03/08/05

  
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